

PATENT
ATTORNEY DOCKET NO. 07678/116002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Krukonis et al.	Art Unit:	1731
Serial No.:	10/623,006	Examiner:	Dionne W. Mayes
Filed:	July 18, 2003	Customer No.:	21559
		Confirmation No.:	4588
Title:	REDUCTION OF CONSTITUENTS IN TOBACCO		

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Applicant requests withdrawal of finality of the Office Action issued in connection with the above-referenced case on April 25, 2006.

Under M.P.E.P. § 706.07, “the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.” This section also states, “Switching … from one set of references to another by the examiner in rejecting successive actions claims of substantially the same subject matter will … tend to defeat attaining the goal of reaching a clearly defined issue for an early termination…” Furthermore, the “applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application.” Finally, a “second … action on the merits in any application … should not be made final if it includes a rejection, on prior art not of record, of any claim amended to

include limitations which should reasonably have been expected to be claimed” (M.P.E.P. § 706.07(a)).

The facts of the case are as follows. On November 23, 2005, the Office issued a non-final action rejecting the present claims for anticipation by Niven (U.S. Patent No. 4,727,889) or obviousness over Niven in combination with two other references. In reply on February 23, 2006, Applicant clarified the independent claims essentially to restate the preamble within the body of the claim. For example, claim 1 was amended as follows:

1. (Currently amended) A method of reducing an amount of a constituent in tobacco, said method comprising the steps of:
 - (a) providing a vessel containing said tobacco comprising said constituent;
 - (b) contacting said tobacco with a subcritical fluid consisting of carbon dioxide or a hydrocarbon wherein said amount of said constituent dissolves in said subcritical fluid; and
 - (c) removing said subcritical ~~carbon dioxide~~ fluid from said vessel, thereby reducing the amount of said constituent in said tobacco.

Applicant’s amendments and arguments were sufficient to remove all rejections of record in the non-final action. The Office, however, issued a Final action on April 25, 2006 citing a new reference (Garner, U.S. Patent No. 2,128,043) as rendering the claimed invention obvious. The Office has stated that the reason for making the Office action final is that “Applicant’s amendments necessitated the … rejection.” In reply to the Final action, Applicant’s provided arguments and evidence on the differences between the claims and the Garner reference and also requested withdrawal of finality to allow Applicant a fair opportunity to respond to the new ground of rejection. In the Advisory

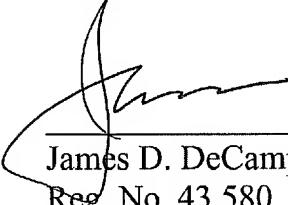
Action mailed on October 13, 2006, the Office deemed Applicant's request as being without merit, without further explanation.

Applicant submits that finality was premature in this case. First, as raised with the Examiner, nothing in the amendments to the claims in response to the first Action changed the scope in such a way as to make Garner applicable to the currently pending claims but not to the claims as originally filed. The rejection over Garner could have and should have been made in the previous Office action, violating the tenets of M.P.E.P. § 706.07. Thus, there are no grounds to state that Applicant's amendment necessitated the rejection. Furthermore, under M.P.E.P. § 706.07(a), amendments that are made to recite the preamble in the body of the claim are clearly limitations which should reasonably have been expected to be claimed, and rejection of such claims over new art is improper. Finally, Applicant should not be prematurely cut off from prosecution while seeking the patent protection to which it is justly entitled. In this case, the Examiner rejected in an Advisory Action Applicant's arguments and evidence provided in reply to the Final action, and Applicant is entitled to a full consideration of the arguments and evidence via a full Office action, as well as one further opportunity to present additional arguments and evidence to develop a clear issue prior to any appeal.

For these reasons, Applicant requests withdrawal of finality. If there are any charges or any credits, kindly apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 25 October 2006


James D. DeCamp, Ph.D.

Reg. No. 43,580

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045